



Express Mail No. EL 998648556 US

10-06-03

FSUM 10463.1
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit 1625

Application of Robert A. Holton
Serial No. 10/609,301
Filed June 27, 2003
Confirmation No. 8048
For C10 HETEROSUBSTITUTED ACETATE TAXANES

October 3, 2003

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS,

SIR:

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Applicant submits herewith, in accordance with 37 C.F.R. 1.97 and 1.98 and MPEP 609, and in compliance with the duty of disclosure set forth in 37 C.F.R. 1.56, the attached PTO/SB/08A for consideration by the Patent and Trademark Office in the above-entitled application and to be made of record herein. Copies of the references cited have not been provided in accordance with 37 C.F.R. § 1.98(d) because they are of record in a prior application Serial No. 09/775,912, filed February 2, 2001 relied upon for an earlier filing date under 35 U.S.C. § 120.

This Information Disclosure Statement is being submitted pursuant to 37 C.F.R. §1.97(b) in that applicants believe that it is being filed prior to the mailing date of the first Office action on the merits. Accordingly, neither a statement nor fee under 37 C.F.R. §1.97(c) or (d) is required. If an Office action was issued prior to the mailing of this Statement, the Commissioner is hereby authorized to charge any fees associated with this Statement to Account No. 19-1345.

Respectfully submitted,

Bradley S. Schammel, Reg. No. 54,667
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

BSS/vlm
*Enclosure

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Sheet 1 of 4

Complete if Known

Application Number	10/609,301
Filing Date	June 27, 2003
Confirmation Number	8048
First Named Inventor	Robert A. Holton
Group Art Unit	1625
Examiner Name	
Attorney Docket No.	FSUM 10463.21

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
		Number	Kind Code ² (if known)		
	1	4,960,790		Stella et al.	10-02-1990
	2	5,175,315		Holton	12-29-1992
	3	5,227,400		Holton et al.	07-13-1993
	4	5,243,045		Holton et al.	09-07-1993
	5	5,283,253		Holton et al.	02-01-1994
	6	5,350,866		Holton et al.	09-27-1994
	7	5,430,160		Holton	07-04-1995
	8	5,556,877		Bouchard et al.	09-17-1996
	9	5,556,878		Kelley et al.	09-17-1996
	10	5,567,614		Patel et al.	10-22-1996
	11	5,614,645		Kingston et al.	03-25-1997
	12	5,714,513		Holton et al.	02-03-1998
	13	5,721,268		Holton et al.	02-24-1998
	14	5,756,536		Chen et al.	05-26-1998

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered.
Include copy of this form with next communication to applicant.

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231.

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Sheet	2	of	4	Attorney Docket No.	FSUM 10463.21
-------	---	----	---	---------------------	---------------

	15	5,767,297		Mandai et al.	06-16-1998
	16	5,780,653		Tao et al.	07-14-1998
	17	5,811,452		Ojima et al.	09-22-1998
	18	5,879,929		Patel	03-09-1999
	19	5,912,264		Wittman et al.	06-15-1999
	20	5,939,561		Bourzat et al.	08-17-1999

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	T ⁶
		Office	Number ⁴	Kind Code ² (if known)			
	21	EP	0 558 959	B1	Bristol-Myers Squibb Co.	09-08-1993	
	22	EP	0 629 701	B1	Bristol-Myers Squibb Co.	12-21-1994	
	23	EP	0 687 259	B1	Rhone-Poulenc Rorer	12-20-1995	
	24	EP	0 882 732	A1	Ensuiro Sugar Refining Co., Ltd.	12-09-1998	
	25	WO	93/18018	A1	University of Florida	09-16-1993	
	26	WO	94/20484	A1	Rhone-Poulenc Rorer S.A.	09-15-1994	
	27	WO	95/11241	A1	Rhone-Poulenc Rorer S.A.	04-27-1995	
	28	WO	96/13495	A1	The Research Foundation of State University of New York	05-09-1996	
Examiner Signature				Date Considered			

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered.
Include copy of this form with next communication to applicant.

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231.

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Sheet	3	of	4	Attorney Docket No.	FSUM 10463.21
-------	---	----	---	---------------------	---------------

	29	WO	97/09979	A1	Florida State University	03-20-1997	
	30	WO	97/16200	A1	Merck & Co., Inc.	05-09-1997	
	31	WO	97/42181	A1	Florida State University	11-13-1997	
	32	WO	98/02426	A1	Kabushiki Kaisha Yakult Honsah	01-22-1998	
	33	WO	99/09021	A1	Florida State University	02-25-1999	
	34	WO	01/57013	A1	Florida State University Research Foundation, Inc.	08-09-2001	

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶
	35	GUERITTE-VOEGELEIN et al. "Relationships between the Structure of Taxol Analogues and Their Antimitotic Activity" Journal of Medicinal Chemistry, Vol. 34, No. 3 (1991) pp. 992-998.	
	36	KANT et al. "A Chemoselective Approach to Functionalize the C-10 Position of 10-Deacetylbaccatin III. Synthesis and Biological Properties of Novel C-10 Taxol Analogues" Tetrahedron Letters, Vol. 35, No. 30 (1994) pp. 5543-5546.	
	37	KINGSTON et al. "The Chemistry of Taxol, A Clinically Useful Anticancer Agent" J. of Natural Products, Vol. 53, No. 1 (1990) pp. 1-12.	
	38	MELLADO et al. "Preparation and Biological Activity of Taxol Acetates" Biochemical and Biophysical Research Communications" Vol. 124, No. 2 (1984) pp. 329-336.	
	39	PULICANI et al. "Direct Access to 2-Debenzoyl Taxoids by Electrochemistry, Synthesis of 2-Modified Docetaxel Analogs" Tetrahedron Letters, Vol. 35 No. 52 (1994) pp. 9717-9720.	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231.

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Sheet

4

of

4

Complete if Known	
Application Number	10/609,301
Filing Date	June 27, 2003
Confirmation Number	8048
First Named Inventor	Robert A. Holton
Group Art Unit	1625
Examiner Name	
Attorney Docket No.	FSUM 10463.21

	40	RAO et al. "Synthesis and Evaluation of Some 10-Mono- and 2',10-Diesters of 10-Deacetylpaclitaxel" Journal of Medicinal Chemistry, Vol. 38, No. 17 (1995) pp. 3411-3414.
	41	SAMARANAYAKE et al. "Modified TAXOLS. 5. Reaction of Taxol with Electrophilic Reagents and Preparation of a Rearranged Taxol Derivative with Tubulin Assembly Activity" J. Org. Chem., Vol. 56, No. 17 (1991) pp. 5114-5119.
	42	STRAUBINGER et al. "Pharmacology and Antitumor Effect of Novel Placlitaxel Formulations" Chapter 8, Edited by G. Georg et al., Taxane Anticancer Agents, Basic Science and Current Status, ACS Symposium Series 583, 207th National Meeting of the American Chemical Society, San Diego, CA (1994) pp. 111-123.
	43	SUFFNESS "Chapter 32. Taxol: From Discovery to Therapeutic Use" Annual Reports in Medicinal Chemistry, Vol. 28 (1993) pp. 305-314.
	44	International Search Report for analogous PCT Application No. PCT/US01/03553 dated June 11, 2001.

Examiner Signature	Date Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231.